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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,612	11/30/2001	Stephen Ewer	42579	6098

7590

10/22/2003

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EXAMINER

TUGBANG, ANTHONY D

ART UNIT

PAPER NUMBER

3729

DATE MAILED: 10/22/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/996,612

Applicant(s)

EWER ET AL.

Examiner

A. Dexter Tugbang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13 and 15-30 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 15-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Upon further consideration by the examiner, the previous restriction requirement (Paper No. 5) has been withdrawn in view of the following.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 13 and 15-20, drawn to a process of assembling a single raceway, classified in class 29, subclass 876.
 - II. Claim 21, drawn to a process of assembling three raceways, classified in class 29, subclass 428.
 - III. Claims 22-30, drawn to a process of assembling four raceways, classified in class 29, subclass 868.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions of Groups I, II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of Group I has separate utility such as the use of one, single raceway to hold wires. The inventions of Groups II and III each have separate utility such as three raceways to guide racecars, and four raceways to hold a greater number or larger wires, respectively. See MPEP § 806.05(d).
4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II and III, the search required for Group II is not required for Groups I and III, and the search required for Group III is not required for Groups I and II, restriction for examination purposes as indicated is proper.

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5. During a telephone conversation with Ms. Tara Hoffman on October 16, 2003, a provisional election was made with traverse to prosecute the invention of Group III, claims 22-30. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13 and 15-21 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

7. The abstract of the disclosure is objected to because the abstract is not directed to the claimed invention. Correction is required. See MPEP § 608.01(b).
8. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

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Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.**

Extensive mechanical and design details of apparatus should not be given.

9. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: A Process of Connecting Raceways with or without a Fitting Base.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 22, 23 and 26-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Bowen et al 5,057,981.

Bowen discloses a method of connecting raceways comprising: joining respective ends of first and second raceways (left conduits 122 in Fig. 4) at first junction areas (end regions of conduits 122 joined at coupling 124) so that the ends of the first and second raceways engage and form a joint at the first junction area; coupling a first cover fitting (left coupling 124 in Fig. 4) over the first junction area so that a portion of the first cover fitting engages each end of the first and second raceways; joining ends of third and fourth raceways (right set of conduits 122 in

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Fig. 4) at a second junction (area occupied by right coupling 124) so that ends (one end at conduit 122 at coupling 150 and another end of the other conduit 122 at support 116) of the third and fourth raceways are spaced apart from one another at the second junction area with a curved base (any curved region along conduit 122) disposed therebetween; and coupling a second cover fitting (right coupling 124) over the second junction area so that a portion of the second cover fitting engages each respective end of the third and fourth raceways, and the first and second cover fittings are substantially identical, which meets all of the limitations of the claimed invention. Bowen further suggests that either one of the couplings can be a miter joint to join any of the raceways (see col. 3, lines 10-12).

Regarding Claim 23, the shape of the raceways shown by Bowen (in Fig. 4) indicates that the first and second raceways and third and fourth raceways, are each substantially perpendicular to one another, respectively.

Regarding Claims 28 and 29, Bowen further teaches first and second support surfaces 116 with the curved base being mounted to either support surface between ends of the third and fourth raceways and placing multiple sets of wires 34 in each of the raceways.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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13. Claims 25 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowen et al.

Bowen teaches the claimed connecting method as relied upon above.

Regarding Claim 25, the claimed “second cover fitting” can be alternatively read as the balloons 12 (in Fig. 1) which completely covers the curved base in another embodiment (Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the one embodiment (Fig. 4) of Bowen by utilizing the balloons as a “second cover fitting”, as taught by another embodiment of Bowen (Fig. 1), to positively provide an alternative decorative pattern (see col. 2, lines 45-55).

Regarding Claim 30, it would have been an obvious matter of design choice to choose any desired radius of the curved base and maximum bend radius of the second set of wires, since the applicants have not disclosed that the claimed feature of having the “radius of the curved base defining a radius equal to or greater than the maximum bend radius of the second set of wires”, solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the radius of wires and radius of the curved base taught by Bowen. Moreover, the claimed “radius” of the second set of wires and curved base does not provide any manipulative difference when compared to the connecting process of Bowen et al.

14. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bowen et al in view of Willette 4,319,075.

Bowen discloses the claimed connecting method further including exposed end sections of each of the bases of the third and fourth raceways engaging portions of the second cover

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fitting (coupling 124). Bowen does not teach removing a section of a cover of each of the third and fourth raceways and exposing corresponding sections of the raceway base.

Willette teaches removing a section of a cover in each of at least two raceways (shown in Fig. 5) to expose corresponding end sections of each of the bases of the raceways to positively allow the rerouting of wires (see col. 1, lines 7-9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Bowen by removing a section of a cover and exposing corresponding end sections of each of the bases of the third and fourth raceways, as taught by Willette, to positively allow the wires of the device of Bowen to be rerouted to additional devices.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

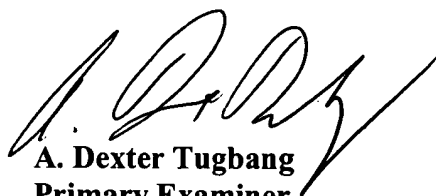
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Dexter Tugbang whose telephone number is 703-308-7599. The examiner can normally be reached on Monday - Friday 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

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A. Dexter Tugbang
Primary Examiner
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October 17, 2003